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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,698	01/19/2005	Volker Klaus Null	TS9505US	1156

7590 06/15/2006

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EXAMINER
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SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/521,698

Applicant(s)

NULL, VOLKER KLAUS

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claim 8 is indefinite in that there is no basis of measuring the required percentages. Furthermore the claim lacks antecedent basis for the particulars of the conversion step, since no conversion step is mentioned in claim 1.

***Response to Arguments***

1. Applicant's arguments filed 4/05/06 have been fully considered but they are not persuasive. Claim 8 lacks antecedent basis for the conversion step referred to therein.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahama et al., US Patent No. 5,242,971 and further in view of Hamner, deceased et al., US Patent No. 4,943,672.

The rejection is repeated for reasons of record. Applicant's invention pertains to a composition comprising

- A) An ethylene-propylene-diene rubber component
- B) A process oil

C) An optional olefin, particularly polypropylene

The process oil of the invention is formed by a method utilizing hydrocracking/hydroisomerizing.

Nakahama et al discloses ethylene-propylene-diene rubbers, elastomer compositions and vulcanized rubbers thereof. The rubbers also include a softener component. Examples of the softeners include petroleum softeners such as *process oil*, lubricating oil, paraffin, liquid paraffin, petroleum asphalt and Vaseline; coal tar softeners such as coal tar and coal tar pitch; fatty oil softeners such as castor oil, linseed oil, colza oil and coconut oil; tall oil; factice; wax such as beeswax, carnauba wax and lanolin; fatty acids and salts thereof such as ricinoleic acid, palmitic acid, barium stearate, calcium stearate and zinc laurate; and synthetic high-molecular materials such as petroleum resin, atactic *polypropylene* and coumarone-indene resin. Among them, petroleum softeners are preferred with *process oil* being particularly preferred. See col. 3, line 19 through col. 8, line 16.

Hamner et al discloses a method for converting Fischer-Tropsch wax to a lubricating *oil* having a high viscosity index and a low pour point by first hydrotreating the wax under relatively severe conditions and thereafter *hydroisomerizing* the hydrotreated wax in the presence of hydrogen on a particular fluorided Group VIII metal-on-alumina catalyst. This is followed by fractionating of the effluent from the previous step to produce a lubricating *oil* fraction boiling above about 640.degree. F. at atmospheric pressure; and then dewaxing the lubricating *oil* fraction from this step to produce a dewaxed lubricating *oil* having a viscosity index of at least 130 and a pour point less than about 0 degree. F. The hydroisomerate is then dewaxed to produce a premium lubricating *oil* base stock. The dewaxing step is accomplished by techniques

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which permit the recovery of unconverted wax. *Solvent dewaxing* is utilized and employs typical dewaxing solvents. Patentee is silent as to specific physical properties of the resulting oils, such as flash point, UV adsorption, evaporation loss and kinetic viscosity. However, because the process of Hamner et al is essentially the same as applicants, it is believed that the resulting oils of Hamner et al would also be essentially the same as applicant's. Hamner et al is thought to inherently disclose the process oils of applicant's invention. See col. 2, line 59 through col. 3, line 18.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the atactic polypropylene and process oils suggested by Nakahama et al into the compositions of Nakahama et al. to derive improved co-vulcanizability with conjugated diene rubbers, excellent weather resistance, ozone resistance and thermal aging resistance without detriment to mechanical characteristics, wear resistance and dynamic fatigue resistance, absent a clear showing of unexpected results attributable to the specific process oil. Likewise, it would have been particularly obvious to one of ordinary skill in the art to select and incorporate the conventional process oils of Hamner et al into the rubber compositions of Nakahama et al., as a suitable process oil, absent a clear showing of unexpected results attributable to the use of the alcohol components.

### *Response to Arguments*

Applicant's arguments filed 4/05/06 have been fully considered but they are not persuasive. Hamner is silent as to the specific physical properties of the resulting process oils of the invention, such as flash point, UV adsorption, evaporation loss and kinetic viscosity. However, because the process of Hamner et al is essentially the same as applicants, it is believed that the

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resulting oils of Hamner et al would also be essentially the same as applicant's. Patentee's failure to disclose every property of a component is not clear indication that the property does not exist within that component. A component and its properties or function may not be separated. Hamner et al is thought to inherently disclose the process oils of applicant's invention, by virtue of the fact that the process oils of Hamner are manufactured by essentially the same process as are applicant's process oils.

It would have been particularly obvious to one of ordinary skill in the art to select and incorporate the conventional process oils of Hamner et al into the rubber compositions of Nakahama et al., as a suitable process oil, absent a clear showing of unexpected results attributable thereto.

### *Conclusion*


2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders  
Primary Examiner  
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